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Application No.: 09/935,869

### REMARKS

The last Office Action of November 16, 2004 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Applicant wishes to note discussions with the Examiner on February 11 and February 16 regarding the amendments to claim 1. The Examiner indicated that the amendment to at least claim 1 distinguish over the prior art of record.

Claims 1-22 are pending in the application. Claims 1 and 22 have been amended. Claim 21 has been canceled. New claim 23 has been added. A total of 22 claims are now on file.

Claim 21 [sic] was withdrawn from examination as being directed to a non-elected invention.

Claims 1, 7, 9, 10, 11, 15 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,222,973 (hereinafter "Sharpe").

Claim 21 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,486,185 (hereinafter "Freitas").

Claims 2-6 stand rejected under 35 U.S.C. §103(a) as being obvious over Sharpe in view of U.S. Pat. No. 5,746,770 (hereinafter "Zeltels").

Applicant acknowledges with appreciation that claims 8, 12, 13, 14 and 17-20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. However, applicant

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wishes to defer allowance until such time that the amended claims have been examined and applicant's arguments and amended claim 22 has been further examined.

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**WITHDRAWAL OF CLAIM 21[sic] AS BEING DRAWN TO A NON-ELECTED  
INVENTION**

With respect to the claim 21, the Examiner was consulted and has orally confirmed that the correct number of the withdrawn claim is 22.

The Examiner determined that the claim was directed to a "cutting" instrument. The preamble of claim 22 stated the instrument as a "cutting" instrument. Applicant submits that this was clearly a typographical error and is out of line with the disclosure and the body of the claim since the body of the claim refers to a holding instrument. As such, the preamble has been corrected to eliminate that term "cutting". Claim 22 must now be examined.

**REJECTION OF CLAIMS 1, 7, 9, 10, 11, 15 and 16 UNDER 35 U.S.C. §102(b)  
AS BEING ANTICIPATED BY SHARPE**

The rejection under 35 U.S.C. 102(b) is respectfully traversed.

The Examiner has recited all structures in claim 1 and alleges that Sharpe discloses same pointing to Fig. 3. Furthermore, the Examiner has provided sketches indicating the "taper" as the jaws of the instrument tapering toward the head piece. However, the head piece as recited in claim 1 is different from the Sharpe head piece. Applicant has amended the claim to more clearly point out the axis in which the taper is oriented. As seen in Fig 7, the taper is shown viewed from the transverse axis of the instrument as defined in the claim. The claim now clearly

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sets forth the viewing direction and it is clear that the taper is distinguishable from the sketches the Examiner shows. The head piece as claimed has tapering arms as seen from FIG. 7 in the application. Sharpe does not show that feature. Therefore Sharpe does not anticipate the invention as claimed in claim 1. The amendments made to claim 1 relate to the axial position of the rod within the probe. Furthermore, the word 'grasping' has been changed to --holding-- to better express that function of the head piece. Applicant asserts that these amendments to claims 1 and 22 have not narrowed these claims to trigger prosecution history estoppel, but merely clarified the purposes of the elements of the combination.

Since claims 7, 9, 10, 11, 15 and 16 are indirectly dependent on claim 1, they distinguish over the cited reference in the same manner as claim 1.

Withdrawal of the rejection of claims 7, 9, 10, 11, 15 and 16 under 35 U.S.C. §102(b) is thus respectfully requested.

#### **REJECTION OF CLAIM 21 UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY FREITAS**

The Examiner's rejection is respectfully traversed.

Claim 21 has been canceled in favor of new claim 23. Claim 23 recited that the housing comprises two semi-circular housing parts that are spring loaded and that the two arms are tapered. The Examiner alleges that Freitas discloses the features of claim 21. Applicant disagrees with this assessment. Freitas does not show the feature that the two arms are configured with *distal end portions that are*

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*substantially transverse to the longitudinal axis.* Freitas shows no such structure. The Freitas instrument is configured as a pliers-type instrument with two arms extending *substantially in longitudinal direction*, which is exactly the opposite of the claimed head piece. When the arms in Freitas are closed as seen in Fig. 2, the arms are locked for a function described as that of a clipper, a scissors or clamp, hence the rather large engagement area of the arms. When the arms are closed, the recess in the Freitas head piece, is set back very far due to the large locking area as to be as to be unable to freely holding any microstructures, and too small for the same purpose.

The Examiner also states that *the two arms starting from the cylindrical rod in direction of the frontal face of the head piece are tapered off with opposing side walls of the taper configured in a straight shape.* As this feature is not seen from the Examiner's description, applicant has clarified the claim by reciting the viewing plane. Accordingly, when viewed from a transverse plane, the Freitas reference does not disclose tapering arms.

In view of the above, applicant believes that new claim 23 patentably distinguishes over the Freitas reference.

Withdrawal of the rejection of claim 21 and allowance of claim 23 under 35 U.S.C. §102(b) is thus respectfully requested.

**REJECTION OF CLAIMS 2-6 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SHARPE IN VIEW OF ZEITELS**

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The Examiner's rejection is respectfully traversed.

In view of the amendment to claim 1, which overcomes the prior art of record, claims 2-6 which incorporates all the features of claim 1 likewise distinguish over the prior art of record.

Withdrawal of the rejection of claims 2-6 under 35 U.S.C. §102(b) is thus respectfully requested.

### CONCLUSION

Applicant believes that when the Examiner reconsiders the claims in the light of the above comments, he will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses a microsurgical instrument showing the features as claimed.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

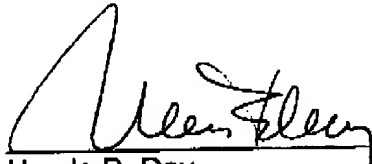
Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner

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feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Commissioner is hereby authorized to charge fees which may be required, or credit any overpayment to Deposit Account No. 06-0502.

Respectfully submitted,

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